

### REMARKS

Claims 1-22 are pending in the present application. Claim 1 has been amended herewith. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 101**

The Examiner rejected Claims 1-22 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

With respect to Claims 1 and 12, the Examiner states "In claims 1 and 12 the applicant claims a method for creating policy groups, moving a data element between groups and generating a privacy policy based upon a privacy group. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts."

Applicants respond to the Claim 1 rejection by showing that Claim 1 has been amended to specifically recite a data processing apparatus-implemented method, and that the recited steps are data processing apparatus-implemented steps. Thus, amended Claim 1 is shown to expressly recite technology and therefore is directed to "useful arts".

Applicants respond to the Claim 12 rejection by showing that, and contrary to the Examiner's assertion, such claim does *not* claim a method. Rather, Claim 12 expressly recites an *apparatus* with corresponding "means for" elements, as shown below:

12. An **apparatus** for creating a privacy policy, comprising:  
creation **means for creating** a policy group;  
movement **means for moving** a data element to the policy group; and  
generation **means for generating** a privacy policy based on the policy group.

Per 35 USC 112, 6<sup>th</sup> paragraph, "means for" elements shall be construed to cover the corresponding structure or material described in the specification and equivalents thereof. Thus, the recited means for elements are shown to not merely describe a process that might be performed without the aid of any technology, as alleged by the Examiner, and Claim 12 is thus shown to have been erroneously rejected under 35 USC 101.

With respect to dependent Claims 2-11 and 13-22, Applicants traverse for reasons given above regarding their respective independent claims.

Therefore, the rejection of Claims 1-22 under 35 U.S.C. § 103 has been overcome.

## II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-22 under 35 U.S.C. § 103 as being unpatentable over Moriconi et al (US Patent 6,158,010) in view of Abraham et al (WO 98/40987). This rejection is respectfully traversed.

Generally speaking, the present invention is specifically directed to *privacy policies*, and in particular to methods and apparatus for creating a *privacy policy*. None of the cited references teach or suggest any type of privacy policy, or the creation of a privacy policy. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants).

Specifically with respect to Claim 1, such claim recites a method for creating a *privacy policy*. In contrast, the teachings in the cited Moriconi reference are directed to ensuring that clients are authorized to access securable components (Col. 13, lines 14-32) by use of a security policy (Claim 1). Security and privacy are two very different concepts, and the teaching of one (security, as taught by Moriconi) does not teach or suggest the other (privacy, as claimed). For example, imagine a person living in a locked, bullet-proof glass house, where the glass is see-through. This locked, bullet-proof glass house is certainly secure, but it is not at all private. As another example, per an article by CIO Magazine dated November 1, 2001 (accessible on the internet at [http://www.cio.com/archive/110101/court\\_sidebar\\_1.html](http://www.cio.com/archive/110101/court_sidebar_1.html)), it states:

### Security Versus Privacy

*The distinctions can be confusing, but security and privacy are indeed different issues*

Without security, there can be no privacy, so the two subjects are forever entwined. Legally, however, the issues are quite different. Fred H. Cate, professor of law at Indiana University and senior policy adviser to the Center for Information Policy Leadership, explains the distinction as succinctly as anyone. "I think of privacy as the use of the data by somebody you gave it to, and security as the theft of the data or the interception of the data by the unknown third party," he says. "If I buy a ticket from Travelocity, what Travelocity does with my data is a privacy issue. If somebody hacks into Travelocity and steals that data, that's a security issue. And we've had a tendency to confuse the two."

Although some cases do involve both security and privacy, two sets of legal precedents are likely to emerge. Privacy lawsuits—such as the ones well-known Attorney Arthur Miller discusses—involve business decisions to use information in a certain way. The security-related lawsuits discussed in this article involve situations where information security fails, causing an unintended use of information or systems.  
—Sarah D. Scalet

Indeed, even the plain dictionary meaning recognizes that these two terms mean very different things. According to The American Heritage Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company, these two terms mean:

#### se·cu·ri·ty

1. Freedom from risk or danger; safety.
2. Freedom from doubt, anxiety, or fear; confidence.
3. Something that gives or assures safety

#### pri·va·cy

1.
  - a. The quality or condition of being secluded from the presence or view of others.
  - b. The state of being free from unsanctioned intrusion: *a person's right to privacy.*
2. The state of being concealed; secrecy.

It is thus shown that a teaching of using a security policy to limit user access to resources (as taught by the cited Moriconi reference) does not teach or suggest any type of privacy policy creation or generation, as claimed. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1, as all the claimed limitations are not taught or suggested by the cited references. In addition, as a proper prima facie showing of obviousness has not been made, the burden has not shifted to Applicants to rebut an obviousness assertion<sup>1</sup>. It is also shown that because of such failure to establish a prima facie showing of obviousness, the rejection under 35 USC 103 is improper<sup>2</sup>.

Applicants traverse the rejection of Claims 2-22 for reasons given above regarding Claim 1.

Therefore, the rejection of Claims 1-22 under 35 U.S.C. § 103 has been overcome.

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<sup>1</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

<sup>2</sup> If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

**III. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 6/7/04

Respectfully submitted,



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